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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,335	07/09/2003	Vlasta Brusic Kaufman	98010CONDIV	1377

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EXAMINER

GOUDREAU, GEORGE A

ART UNIT	PAPER NUMBER
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1763

DATE MAILED: 05/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/616,335

Applicant(s)

KAUFMAN ET AL.

Examiner

George A. Goudreau

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

George A. Goudreau
GEORGE GOUDREAU
PRIMARY EXAMINER

5-061

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. This action will not be made final due to the new grounds of rejection.
2. Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

-The wording used in part a of claim 1 is written in very confusing manner, and should be reworded. (i.e.-Applicant recites that their cmp slurry does not contain a film-forming agent. However, every liquid will form a type of film with the surface of a substrate in which it is in contact. Thus, the examiner does not understand how applicant's cmp slurry is able to avoid the formation of any type of film on the surface of a substrate, which is in contact with a cmp slurry. Further, applicant recites compounds in their cmp slurry, which are known to form films, which are both physically, and chemically bonded to the surface of the substrate in which it is in contact with. These include the complexing agents, and the surfactants, in the cmp slurry, which are recited by the applicant. The examiner doesn't understand why these same compounds act as film-forming agents in cmp slurries, which are claimed by the applicant in other patents, which were issued to applicant while they do not exhibit similarly film-forming behavior in the cmp slurry, which is claimed in the present application. Further, chelating agents in a cmp slurry work by physically, and chemically bonding to the surface of a substrate to be cmp polished to form a film. Thus, the examiner cannot tell what applicant is trying to claim. This makes any meaningful search, and evaluation of applicant's claims difficult if not impossible.)

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3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-19 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-38 of U.S. Patent No. 5,783,489.

Although the conflicting claims are not identical, they are not patentably distinct from each other because of the same reasons as those stated in paragraph 4 of the previous office action.

5. Claims 1-15 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 17-26 of U.S. Patent No. 5,980,775

Although the conflicting claims are not identical, they are not patentably distinct from each other because of the same reasons as those stated in paragraph 6 of the previous office action.

6. Claims 1-15 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 11-18 of U.S. Patent No. 6,068,787

Although the conflicting claims are not identical, they are not patentably distinct from each other because of the same reasons as those stated in paragraph 7 of the previous office action.

7. Claims 1-15 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 6,316,366.

Although the conflicting claims are not identical, they are not patentably distinct from each other because of the same reasons as those stated in paragraph 8 of the previous office action.

8. Applicant's arguments filed 3-21-06' have been fully considered but they are not persuasive.

Applicant argues the following points regarding the examiner's rejection of their claimed subject matter.

-The examiner has incorrectly made ODP rejections of their claims. These ODP rejections were made over the claims in issued patents in which the recited cmp slurries contain no complexing agents in contrast to the claims in the pending application, which do. The compounds, which the examiner states inherently act as complexing agents in the cmp slurries claimed in the issued patents have different functions (i.e.-non-chelating functions) than the chelating function, which is recited in the claims in the pending application. Thus, the claims in the


pending application cannot be properly rejected under ODP over the claims in these patents.

The examiner must disagree.

-The examiner does not understand how the same compounds, which are claimed in the cmp slurry recited in the present application, behave as chelating agents while they do not do so in the cmp slurries, which are recited in the claims of the issued patents, which were used to reject applicant's claims under ODP. One skilled in the cmp polishing arts would expect these same compounds to exhibit similar chemical reactivity in the cmp slurries recited in the claims of the issued patents as they do in the cmp slurries recited in the claims of the pending application. This is especially true when one considers the fact that the same assignee owns the issued patents, and the pending application. Thus, it would have been expected that these issued patents are directed toward solving similar problems to those addressed in the present application. Thus, the same compounds, which are recited as chelating agents in the present application, would have been expected to have behaved as chelating agents in the cmp slurries, which are recited in the issued patents.

9. Any inquiry concerning this communication should be directed to examiner

George A. Goudreau at telephone number (571)-272-1434


George A. Goudreau
Primary Examiner
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